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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,672	02/09/2004	Ke-Chi Jang	22171.319	9436
27683	7590	04/07/2006	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			PEACHES, RANDY	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/774,672

Applicant(s)

JANG ET AL.

Examiner

Randy Peaches

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 8-35 is/are rejected.
- 7) ☐ Claim(s) 30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Specification

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. ***Claims 14, 22 and 30*** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows:

a. "...or to prevent NESPD independent of a particular value added service provided for which NESPD is requested."

b. second status indicator (claim 30).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 8-28** are rejected under 35 U.S.C. 102(b) as being anticipated by Havinis et al. (U.S. Patent Number 6,311,069 B1).

Regarding **claim 8**, Havinis et al. discloses a telecommunication system, which reads on claimed "wireless communication system," comprising:

- a station having communication logic, which reads on claimed "software," for: receiving a capability request, wherein capability request is interpreted as information regarding location or position information of a mobile station (MS, 20). See column 3 lines 56-62 and column 4 lines 26-30; and
- generating and transmitting a capability request response that includes a status indicator of a non-emergency-services position-determination (NESPDP) capability, wherein the NESPDP capability is user-selectable. See column 6 lines 4-22 and lines 42-50.

Regarding **claim 9**, according to **claim 8**, Havinis et al. continues to disclose wherein the capability request response further includes at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding **claim 10**, according to **claim 8**, Havinis et al. continues to disclose wherein the station is a first said MS (20) and the communication logic is first receiving logic

(24), the said telecommunication system further comprising a second station, MSC (14) having second communication logic (13) for generating and transmitting the capability request. See column 5 lines 27-29.

Regarding **claim 11**, according to **claim 10**, Havinis et al. continues to disclose wherein the said MSC (14) comprises positioning logic, which reads on claimed "position determining element." See column 6 lines 31-37.

Regarding **claim 12**, according to **claim 8**, Havinis et al. continues to disclose wherein the station is a said MS (20). See column 4 lines 49-53.

Regarding **claim 13**, according to **claim 8**, Havinis et al. continues to disclose wherein the said station is selected from the group consisting of: a cellular phone, a wireless enabled personal digital assistant, a wireless-enabled personal computer, a GPS device, and a pager. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

Regarding **claim 14**, Havinis et al. discloses a method of communicating between telecommunications network stations, comprising:

- receiving at a MS (20) a capability request transmitted by a MSC (14). See column 5 lines 27-40;

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- generating at the said MS (20) a capability request reply in response to the capability request, wherein the capability request reply includes a status indicator of a non-emergency-services position-determination (NESPД) capability of said MS (20), the NESPД capability being user-selectable. See column 6 lines 1-12; and
- transmitting the capability request reply to the said MSC (14). See column 6 lines 4-12.

Regarding **claim 15**, according to **claim 14**, Havinis et al. continues to disclose wherein further comprising:

- generating the capability request at the said MSC (14). See column 5 lines 66-67;
- transmitting the capability request from the said MSC (14) to the said MS (20). See column 5 lines 27-36; and
- receiving the capability request reply at the second station. See column 6 lines 4-12.

Regarding **claim 16**, according to **claim 14**, Havinis et al. continues to disclose selecting the NESPД capability, wherein the said MS (20) has the option to accept or reject the request. See column 6 lines 13-22.

Regarding **claim 17**, according to **claim 16**, Havinis et al. continues to disclose wherein

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the NESPd capability is selected by the said MS (20) user. See column 6 lines 13-22.

Regarding **claim 18**, according to **claim 14**, Havinis et al. continues to disclose wherein the said MSC (14) comprises a HLR (26), which reads on claimed "stationary position determining element," and the said MS (20) comprises a wireless mobile device. See column 1 lines 39-43 and column 6 lines 61-67.

Regarding **claim 19**, according to **claim 14**, Havinis et al. continues to disclose wherein the capability request reply comprises MS (20) identity, which is either and accept or reject response (column 6 lines 14-22), including at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding **claim 20**, according to **claim 14**, Havinis et al. continues to disclose wherein generating a position determination request at the said MSC (14) and transmitting the position determination request to the said MS (20) based on an accept or reject response. See column 6 lines 31-38.

Regarding **claim 21**, according to **claim 14**, Havinis et al. continues to disclose wherein terminating position determination activity at the said MSC (14) based on a default or reject response from the said MS (20). See column 6 lines 23-31.

Regarding **claim 22**, Havinis et al. discloses a mobile station (MS, 20), comprising:

- a display (27), which reads on claimed "user-interface," for selecting a non-emergency-services position-determination (NESPd) capability. See column 5 lines 37-40;
- a generator configured to generate a signal, wherein the signal can one of a tone or display of the requesting LA (column 5 lines 32-37) comprising a status indicator of the NESPd capability and zero or more wireless mobile device native capability data; and
- a transmitter configured to transmit the signal to a wireless network element.

See column 6 lines 7-12.

Regarding **claim 23**, according to **claim 22**, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on an external request received from a wireless network element. See column 6 lines 13-22.

Regarding **claim 24**, according to **claim 14**, Havinis et al. continues to disclose wherein the transmitter of the said MSC (14) when a default response is received by the said MS (20), is configured to transmit the signal based on stimulus exclusive of an external request for the status of the NESPd capability. See column 6 lines 23-27.

Regarding **claim 25**, according to **claim 24**, Havinis et al. continues to disclose wherein

the stimulus comprises a position-related request, which the said MS (20) has rejected.

See column 6 lines 13-22.

Regarding **claim 26**, according to **claim 22**, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on a stimulus comprising an external request for the status of the NESPD capability by responding immediately to a request by either accepting or rejecting the request. See column 6 lines 13-22.

Regarding **claim 27**, according to **claim 22**, Havinis et al. continues to disclose wherein the zero or more is one or more. See column 3 lines 62-67.

Regarding **claim 28**, according to **claim 22**, Havinis et al. continues to disclose wherein the said MS (20) is selected from the group consisting of: a mobile telephone; a personal computer with a wireless modem; a GPS device; a pager; and a wireless-enabled PDA. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

Regarding **claims 29**, Havinis et al. discloses a method of operating an element of a wireless communication network, comprising:

- transmitting a non-emergency services position determination message to a mobile station. See column 5 lines 27-36;
- receiving a status indicator from the mobile station, at least indirectly, wherein the status indicator indicates that the mobile station is configured to refrain from

providing position information for non-emergency services. See column 6 lines 4-22 and lines 42-50; and

- preventing a plurality of NESPД messages from being transmitted to the said MS in response to receiving the status indicator. See column 6 lines 23-31.

Regarding **claim 31**, according to **claim 29**, Havinis et al. discloses a message from a said NESPД regarding the service that is dependent on the said MS's position within the said network. See column 6 lines 31-38.

Regarding **claim 32**, according to **claim 29**, Havinis et al. continues to disclose wherein the said status indicator indicates whether the mobile station is configured to:

- refrain from providing information for all non-emergency services. column 6 lines 4-22 and lines 42-50;
- provide position information for all non-emergency services. See column 2 lines 28-41.

Regarding **claim 33**, according to **claim 29**, Havinis et al. continues to disclose wherein the status indicator indicates whether the mobile station is configured to provide or refrain from providing position information for NESPД in a manner independent of any particular NESPД. See column 6 lines 4-22 and lines 42-50.

Regarding **claim 34**, according to **claim 29**, Havinis et al. continues to disclose wherein the element is a Service Mobile Location Center (SMLC), which reads on claimed "position determining entity." See column 2 lines 25-28.

Regarding **claim 35**, according to **claim 29**, Havinis et al. continues to disclose wherein the status indicator is included in a message further containing native capability data of the said MS. See column 5 lines 32-37.

Allowable Subject Matter

Claim 30 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

4. Regarding the rejection under 35 U.S.C 101, the Applicant has overcome the rejection.

5. Applicant's arguments filed 1/05/2006 have been fully considered but they are not persuasive. Regarding **claim 8**, the Applicant asserts that that the cited prior art of Havinis does not disclose generating and transmitting a capability request response that includes a status indicator of a non-emergency services position determination (NESPd) capability of a wireless communication system station, wherein the NESPd capability of the station is user selectable to enable or disable all NESPd irrespective of

which non-emergency services provider is associated with the capability request. The Examiner respectfully adheres the comments submitted by the Applicant; however, after careful consideration the claimed invention, the Examiner maintains his position. Havinis clearly details in the cited columns and lines that a said mobile subscriber associated with the MS can accept or reject the positioning request based upon the location area identity displayed on the display. Havinis, as disclosed in the instant claim, teaches wherein the user is able to select whether or not his/her position is to be disclosed by providing a status indicator. The Examiner would like to further state that the interpretation of the Applicant's claimed invention, "non-emergency services positioning determination" is interpreted as any situation or event other than an emergency event.

Regarding *claims 14, 22 and 30* the Examiner respectfully brings to the Applicant's attention that the amended language is deemed as "new matter" per the above Office Action.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Randy Peaches
March 24, 2006


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER